

Applicant : Perry R. DeYoung
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REMARKS

Claims 1-66 are pending in the present application. In the Office Action, the Examiner has stated that Applicant is required to elect an invention for prosecution between a first set of claims drawn to a food press with a specific press structure (Group I) and a second set of claims drawn to a food press with a knife assembly (Group II).

Applicant elects Group I of the claims with traverse. Group I of the claims is drawn to a food press with a press plate and includes claims 1-6, 9, 14-22, 25, 26 and 31-62. Additionally, new claims 63-66 belong in Group I because claims 63-66 require the specific details of the press plate configuration as claimed in claims 9, 25, 45 and 55, respectively. Furthermore, as discussed below, claims 7, 8, 10-13, 23, 24 and 27-30 belong in Group I.

Regarding the restriction for subcombinations usable together, distinct claims each claiming subcombinations usable together that contain species under a genus (or generic) claim must have the question of restriction determined by both the practice applicable to election of species and the practice applicable to related inventions. The inventions of Groups I and II include dependent claims that are all dependent on independent claim 1, and as such, the subcombinations are claimed under a common genus claim. Specifically, claim 1 is a generic claim. In other words, claim 1 reads upon all of the claims that depend from claim 1. Moreover, the Examiner has indicated that all of the claims in Group I and Group II are claims drawn to a subcombination.

An independent claim cannot be considered a combination relative to a "subcombination" claim that depends from that independent claim. A subcombination, by definition, includes less than all of the elements of the combination. A dependent claim clearly cannot include less than all of the elements of the claim(s) on which it depends. Accordingly, for example, claim 2 (Group I) and claim 7 (Group II) are all combination claims, with claim 1 being the subcombination claim of each of these claims. Therefore, claim 1 is readable on all of its dependent claims and is therefore generic to all of the claims that depend upon claim 1. Clearly, the dependent claims in the groups include all the elements of claim 1, from which claims 2-17, 35, 36 and 63 depend. Therefore, claims 2-17, 35, 36 and 63 are all species disclosed under a claimed genus and related. Accordingly, the requirements for election of

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species must also be applied. Such an analysis was not made by the Examiner.

Nevertheless, claimed elements of different groups as defined by the Examiner may be usable together. Therefore, such components are not mutually exclusive of one another. For an election of species requirement to be proper, the two claimed species must be mutually exclusive of one another and may not be used together in the combination. Because the Examiner has failed to apply the criteria for election of species and because the criteria would not apply in this instance, Applicant submits that the restriction requirement between the groups is improper.

Furthermore, claimed subcombinations must be disclosed as usable together in a single combination. "Two or more claim subcombinations, disclosed as useful together in a single combination, and which can be shown to be separately usable, are usually distinct from each other." M.P.E.P. § 806.05(b). Groups I and II are not subcombinations that are disclosed as usable together in a single combination. As an example, claim 2 (Group I) and claim 7 (Group II) are claims that do not define subcombinations disclosed as usable together in a single combination. Claims 2 and 7 are all dependent claims. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference and to the dependent claim." 37 C.F.R. § 1.75(c).

If claims 2 and 7 each define a subcombination as stated by the Examiner, the subcombinations combined together in a single combination would include at least two identical hoppers, two identical latch assemblies and two identical press plates. However, no such combination is disclosed in the present application. Therefore, the claims in Groups I and II are not subcombinations that should have been subject to a restriction requirement. The remaining claims made subject to the restriction requirement can be analyzed as discussed above.

Upon reviewing the Examiner's statements as to why the claims are restricted, it is apparent that the Examiner may be considering dependent claims as though they were independent claims. Applicant submits that the restriction requirement as presented is clearly erroneous and therefore submits that the restriction requirement regarding subcombinations usable together should be withdrawn. Therefore, the claims identified in Groups I and II

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should be examined with the election of Group I. Accordingly, Applicant submits that all claims should be examined along with the election of Group I.

As a final remark, Applicant notes that the current restriction made in this Office Action was made previously during the prosecution of the present application. Applicant petitioned this previous restriction on October 15, 2002 and the petition was granted. Accordingly, it has already been decided that the claims of this application do not define subcombinations usable together as set forth in the current Office Action. Applicant notes that an improper restriction adds a significant financial burden, including an additional filing fee, publication fee, issue fee and maintenance fee, which total close to an additional \$10,000 in Patent Office fees alone.

Applicant's election of Group I therefore requires the Examiner to examine claims 1-66.

All pending claims 1-66 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

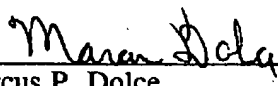
Respectfully submitted,

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1/22/04



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